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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,465	12/02/2003	Donald B. McDugle	P114519	5858

22931 7590 11/20/2006

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EXAMINER

SWINEHART, EDWIN L

ART UNIT PAPER NUMBER

3617

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,465

Applicant(s)

MCDUGLE ET AL.

Examiner

Ed Swinehart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 30-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's disclosed Offer for Sale of the claimed invention.

Applicant's disclosed device offered for sale more than one year before filing shows the invention as claimed. The central thruster section with a pair of extensions for preventing ambient air from entering the thruster are clearly shown in the detailed drawings provided, and discussed in the accompanying Declaration. The claimed dimensions are clearly shown in the provided evidence.

3. Claims 1-29 and 39-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosed Offer for Sale of the claimed invention in view of Den Ouden.

Applicant's disclosed for sale device was mounted below the bottom edge of the transom, and therefore would not be clear of the water during high speed maneuvering, and therefore would present a high degree of drag, as would be known to the ordinary routineer working in the art.

Den Ouden teaches the positioning of such a thruster so that it is clear of the water when the boat is operated at high speed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to raise the position of the thruster disclosed by Applicant to a position as taught by Den Ouden, such that it would clear the water when the boat is at high speeds.

Such a combination would have been desirable at the time of the invention so as to provide for reduced drag.

Re claim 12, as shown in the provided evidence, the extent is "about" 25% or 30% as claimed.

Re claim 16, the illustrated width is considered to be "about" 40% as claimed. Furthermore, it would have been well within the level of skill of the ordinary routineer working in the art at the time of the invention to size the device as claimed. For example, when placing the device on boats of various widths, such sizing would provide no unexpected results.

4. Claims 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's disclosed Offer for Sale of the claimed invention in view Stallman.

Applicant's disclosed Offer for Sale of the claimed invention, prior to the critical date of 11/6/2001, did not incorporate a flange extending about the extension inlet as claimed.

Stallman teaches a flange extending about an inlet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a flange to Applicant's disclosed device Offered for Sale as taught by Stallman.

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Such a combination would have been desirable so as to prevent the entry of air into the inlet.

5. Applicant's arguments filed 9/11/2006 have been fully considered but they are not persuasive.

6. The Declarations filed on 9/11/2006 under 37 CFR 1.131 or 1.312 have been considered but is ineffective to overcome the Offer for Sale reference.

Firstly, the offer for sale constitutes a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131. Applicant in the Declaration filed 9/13/2004 indicates a Reduction to Practice of 3 weeks after September 2001, which would be late September to the middle of October 2001. This reduction to practice date precedes the critical date of 11/6/2001. Experimental use "means perfecting or completing an invention to the point of determining that it will work for its intended purpose." Therefore, experimental use "ends with an actual reduction to practice." *RCA Corp. v. Data Gen. Corp.*, 887 F.2d 1056, 1061, 12 USPQ2d 1449, 1453 (Fed. Cir. 1989).

The Declarations state that such a sale was not a commercial venture, but experimentation.

Although such may have true to such a point, once the invention has been reduced to practice, such experimentation has ended. The fact that certain claims of the present invention are rejected under 102(b) based upon the device offered for sale is evidence of reduction to practice.

Applicant argues that it was the purchaser who contacted him, and therefore he did not "solicit" a sale.

Such has no bearing on the issue, as a sale was made, and there was a reduction to practice of a sold device.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

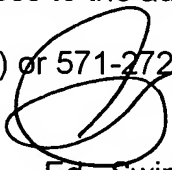
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Swinehart whose telephone number is 571-272-6688. The examiner can normally be reached on Monday through Thursday 6:30 am to 2:00 pm..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ed Swinehart
Primary Examiner
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